



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/792,038 | 03/03/2004 | Melissa K. Rath | ATMI-668 | 4823 |
| 24239 | 7590 | 02/24/2009 | EXAMINER | |
| MOORE & VAN ALLEN PLLC | | | LE, HOA VAN | |
| P.O. BOX 13706 | | | | |
| Research Triangle Park, NC 27709 | | | ART UNIT | PAPER NUMBER |
| | | | 1795 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 02/24/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|-----------------|--------------|
| <i>Office Action Summary</i> | Application No. | Applicant(s) |
| | 10/792,038 | RATH ET AL. |
| | Examiner | Art Unit |
| | Hoa V. Le | 1795 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 January 2009.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,4-7,10,14,15,17-21,24-31,33-35,39,43-50,53-57 and 59 is/are pending in the application.

4a) Of the above claim(s) 7,14,24-31,33-35,39,43-50, 54-55 and 58-59 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,2,4-6,10,15,17-21,53 and 56 is/are rejected.

7) Claim(s) 57 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 08/05/08.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

This is in response to Papers filed on 01/15/09.

I. There has been on the record:

The record shows that applicants elect specie of Formula G. It is that:

Upon the allowance of a generic claim (especially, the instant claim 1 is read on the elected Formula G specie) ", applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

II. The elected Formula G with "0.10" of the mixture "oxirane" (being known in the art as ethylene oxide gas form), ("methyl-, polymer with oxirane or mono(octylphenyl)ether" as claimed (has been considered and searched as an agent being in a mixture with an amount of an ethylene oxide gas. A reading in any other way is an issue of a new matter)). The elected species have not been found.

III. In view of the amendment, (1) the prior art rejections mailed on 05/06/08 have been withdrawn, (2) new searches are made and (3) references are found with respect to Koito et al (2003/0130147 and 2004/0029051).

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 10, 15, 19-20 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koito et al (2003/0130147) considered in view of En et al (2004/0134682) or Sato et al (5,849,467).

Koito et al disclose, teach and suggest a cleaning (stripping and removing) composition of an unwanted material. The composition comprises a quaternary base and adenine. Please see the whole disclosure, especially on paragraphs 0031, 0045, 0077, 0085.

Koito et al do not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774 or in Sato et al on at least on col.3:52 to 4:61, 5:41-48, 7:34-48, Examples 1, 5 and 8.

Since the above references are all related to cleaners, removers and/or strippers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

V. Applicant's arguments filed 01/15/09 have been fully considered but they are not persuasive.

The record shows that applicants amend the claims (especially claim). It results in withdrawal of the prior art rejection mailed on 09/15/08.

The arguments are not applied to the above rejection being applied with new set of the references.

VI. The statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,

164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-6, 10, 15, 17-21, 53 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6, 12-17, 33-36, 39, 42-47 as amended on 01/10/08 of copending Application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5. However, applicants, assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al ((2004/0134682) as a secondary reference).

Applicants in the applied broad claims with “comprising” and the broad teachings and/or suggestion in their specification are related to a cleaning composition containing chemical ingredients and their amounts as those in the instant claims. But, applicants in the applied broad claims with “comprising”

and the broad teachings and/or suggestion do not specify an alkali base.

However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774.

Since the above references are all related to cleaners, stripper and/or removers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 01/15/09 have been fully considered but they are not persuasive.

It is correct that the above rejection are applied with parts of the disclosure as broadly taught and suggested by applicants in the applied application together with the embodiments in the applied claims as amended on 10/10/08.

Applicants disagree to the applied parts of the disclosure as broadly taught and suggested by applicants in the applied application (10/389,214) being acknowledge. It is allowed or permitted by law to apply part or parts of the broadly disclosed, taught and/or suggested embodiments in the applied application 10/389,214 in or with the broadly claimed embodiments in 10/389,214 with a reasonable explanation or rational because a broad claim (such as independent claim 33 for an example) with “comprising” does not specify one or more embodiments (such as an additive selected from as a surfactant, a chelating agent and/or corrosion inhibitor...) that does not allow one skilled in the art and/or an average skill artisan at the time the invention was made to read that claim 33 could further contain one or more embodiments (such as an additive selected from as a surfactant, a chelating agent and/or corrosion inhibitor...) as broadly disclosed, taught and suggested by applicant in 10/389,214. RATIONAL: The language “comprising” in the broadly applied embodiments in the claims in 10/389,214 does not exclude one or more embodiments as broadly taught and suggested by applicants in the applied application 10/389,214. In the absence of convincing evidence to the contrary (such as “consisting of” in the applied claims in 10/389,214), one skilled in the art and/or an average skill artisan at the time the invention was made could read as one or more of the embodiments in 10/389,214

as broadly taught and suggested by applicants in 10/389,214 or with one or more applicant's broadly claimed embodiments in 10/389,214 that results in sufficient embodiments as being not patentably distinct from the those of the rejected claims in this application.

Since assignee and the counsel are limitedly set forth and urged for the limitation of "comprising" in the applied claims in 10/389,214 as that of --- consisting of--- in the art, one should rely on assignee and counsel's statements and arguments on and for the record and insist on each of them for not allowing or permitting anyone of the embodiments in any application to be added or read on or with anyone embodiment form any application to any claims other than those as originally filed until a timely and proper terminal disclaimer is filed on and for the record to be checked and approved on and for the record during the prosecution. One should be first to look and take each of the issues on the record to a full and complete satisfaction before allowing or permitting any other issue to be taken as narrowly set forth and urged for the claimed embodiments by assignee and counsel with "comprising" limitation as that of ---consisting of--- on and for the record because a benefit may be found and obtained.

VII. Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

VIII. Koito et al (2004/0029051) is cumulative for now but may be later applied.

IX. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

02/11/09